



PATENT

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Title: "System and Technique for Automatically Associating Related Advertisements to Individual Search Results Items of a Search Result Set" **#9**

Applicants: Emens et al.

Attorney Docket No.: AM9-99-0118

Serial No.: 09/583,516

Examiner: Raquel Alvarez

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APPEAL BRIEF

Dear Sir:

10 This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellants' Notice of Appeal filed February 3, 2004.

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(1) Real Party in Interest

The real party in interest is International Business Machines Corporation.

(2) Related Appeals / Interferences

No other appeals or interferences exist that relate to the present application or appeal.

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(3) Status of Claims

Claims 1-3, 5-23, and 25-37 are pending and remain in the application. By the Final Office Action dated December 3, 2003, the Examiner (1) has rejected claims 1-3, 5-12, 15-20, 22-29, and 31-36 under 35 U.S.C. § 102(b) as being anticipated by Skillen et al. WO 98/36366 (hereinafter "Skillen") and (2) has rejected claims 13, 14, 21, 30, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Skillen. All of the pending claims and all of the rejections are hereby appealed. A copy of the appealed claims is enclosed herewith as Appendix A.

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(4) Status of Amendments

No amendments are outstanding.

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(5) Summary of Invention

The present invention relates to a system and technique of targeting *at least one* associated advertisement from an Internet search having access to an information repository by a user, including (1) *identifying* at least one *search result item* from a search result of the Internet search by the user, (2) searching for the *at least one* associated advertisement within said repository using the at least one *search result item*, (3) identifying the *at least one* associated advertisement from the repository having *at least one* word that matches the at least one *search result item*, and (4) correlating the *at least one* associated advertisement with *the at least one search result item*.

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(6) Issues Presented for Review

The issues for review are (1) whether claims 1-3, 5-12, 15-20, 22-29, and 31-36 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Skillen and (2) whether claims 13, 14, 21, 30, and 37 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Skillen.

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(7) Grouping of Claims

Claims 1-3 and 5-15 are grouped together and stand and fall together.

Claims 16-21 are grouped together and stand and fall together.

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Claims 22-23 and 25 are grouped together and stand and fall together.

Claims 26-30 are grouped together and stand and fall together.

Claims 32 and 33 are grouped together and stand and fall together.

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Claims 35-37 are grouped together and stand and fall together.

(8) Arguments

A. Introduction

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The issues for review are (1) whether claims 1-3, 5-12, 15-20, 22-29, and 31-36 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Skillen and (2) whether claims 13, 14, 21, 30, and 37 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Skillen.

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B. Whether claims 1-3, 5-12, 15-20, 22-29, and 31-36 are unpatentable under 35 U.S.C. § 102(b) as being anticipated by Skillen

Applicants respectfully traverse the anticipation rejection of claims 1-3, 5-12, 15-20, 22-29, and 31-36, and submit that claims 1-3, 5-12, 15-20, 22-29, and 31-36 are not anticipated by Skillen, and are patentable thereover. In support of this position, Applicants submit the following arguments:

1. Legal Standard for Lack of Novelty (Anticipation)

The standard for lack of novelty, that is, for "anticipation," is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements, and the burden of proving such anticipation is on the party making such assertion of anticipation. Anticipation cannot be shown by combining more than one reference to show the elements of the claimed invention. The amount of newness and usefulness need only be minuscule to avoid a finding of lack of novelty.

The following are two court opinions in support of Applicants' position of non anticipation, with emphasis added for clarity purposes:

- "Anticipation under Section 102 can be found only if a reference shows **exactly** what is claimed; where there are **differences** between the reference disclosures and the claim, a rejection must be based on obviousness under Section 103." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).
- "**Absence** from a cited reference **of any element** of a claim of a patent negates anticipation of that claim by the reference." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986), on rehearing, 231 USPQ 160 (Fed. Cir. 1986).

2. Application of the Anticipation Standard to the Present Invention

By the Final Office Action dated December 3, 2003, the Examiner has rejected claims 1-3, 5-12, 15-20, 22-29, and 31-36 under 35 U.S.C. § 102(b) as being anticipated by Skillen et al. WO 98/36366 (hereinafter "Skillen"). In order to be an anticipation of a claim under 35

U.S.C. § 102(b), a reference must teach every element of the claim, including the relationships between the elements. If any element is not fully taught by the reference, the rejection cannot be sustained.

Evaluating Skillen in this light, it is appropriate to examine the portions of Skillen which the Examiner has pointed to as teaching the claimed elements.

Claims 1-3, 5-12, 15, 22, 23, and 25

Claim 1

To the extent the Examiner's language at page 3 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 1, as amended:

| <u>Claim 1</u> | <u>Skillen</u> |
|--|---|
| A method of targeting <i>at least one</i> associated advertisement from an Internet search having access to an information repository by a user, comprising: <i>identifying</i> at least one <i>search result item</i> from a search result of said Internet search by said user; searching for said <i>at least one</i> associated advertisement within said repository using said at least one <i>search result item</i> ; identifying said <i>at least one</i> associated advertisement from said repository having <i>at least one</i> a word that matches said at least one <i>search result item</i> ; and correlating said <i>at least one</i> associated advertisement with said <i>at least</i> | - - <u>Skillen</u> does not teach this claim element. <u>Skillen</u> does not teach this claim element. <u>Skillen</u> does not teach this claim element. |

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| one search result item. | |
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In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 1, Skillen fails to teach “searching for said *at least one* associated advertisement within said repository using said at least one *search result item*”, as required by claim 1. Instead, Skillen teaches away from this claim element by teaching “[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument”, where the initial search argument is not the “at least one *search result item*” required in claim 1. (See Skillen, page 9, line 37 and page 10, lines 1-11.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, page 9, line 37 and page 10, lines 1-11.) In contrast, claim 1 uses the result of an Internet search, the “at least one *search result item*”, as an input to a search of a repository of advertisements. Thus, Skillen cannot teach this element of claim 1.

For similar reasons, Skillen cannot teach “identifying said *at least one* associated advertisement from said repository having *at least one* word that matches said at least one *search result item*” and cannot teach “correlating said *at least one* associated advertisement with said *at least one search result item*”, as required by claim 1. It is therefore clear that Skillen cannot teach each element of claim 1 and, therefore, a rejection of claim 1 under 35 U.S.C. § 102(b) is inappropriate.

Claims 2, 3, 5-12, and 15

Since dependent claims 2, 3, 5, and 6 depend on independent claim 1 and since Skillen cannot teach each element of claim 1, Skillen also cannot teach each element of claims 2, 3, 5, and 6, and therefore, a rejection of claims 2, 3, 5, and 6 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claims 7-12 depend on claim 6 and since Skillen cannot teach each element of claim 6, Skillen also cannot teach each element of claims 7-12, and therefore, a rejection of claims 7-12 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claim 15 depends on claim 8 and since Skillen cannot teach each element of claim

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|-------------------------|--|
| one search result item. | |
|-------------------------|--|

In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 1, Skillen fails to teach “searching for said *at least one* associated advertisement within said repository using said at least one *search result item*”, as required by claim 1. Instead, Skillen teaches away from this claim element by teaching “[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument”, where the initial search argument is not the “at least one *search result item*” required in claim 1. (See Skillen, page 9, line 37 and page 10, lines 1-11.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, page 9, line 37 and page 10, lines 1-11.) In contrast, claim 1 uses the result of an Internet search, the “at least one *search result item*”, as an input to a search of a repository of advertisements. Thus, Skillen cannot teach this element of claim 1.

For similar reasons, Skillen cannot teach “identifying said *at least one* associated advertisement from said repository having *at least one* a word that matches said at least one *search result item*” and cannot teach “correlating said *at least one* associated advertisement with said *at least one search result item*”, as required by claim 1. It is therefore clear that Skillen cannot teach each element of claim 1 and, therefore, a rejection of claim 1 under 35 U.S.C. § 102(b) is inappropriate.

Claims 2, 3, 5-12, and 15

Since dependent claims 2, 3, 5, and 6 depend on independent claim 1 and since Skillen cannot teach each element of claim 1, Skillen also cannot teach each element of claims 2, 3, 5, and 6, and therefore, a rejection of claims 2, 3, 5, and 6 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claims 7-12 depend on claim 6 and since Skillen cannot teach each element of claim 6, Skillen also cannot teach each element of claims 7-12, and therefore, a rejection of claims 7-12 under 35 U.S.C. § 102(b) is inappropriate. Since dependent claim 15 depends on claim 8 and since Skillen cannot teach each element of claim

8, Skillen also cannot teach each element of claim 15, and therefore, a rejection of claim 15 under 35 U.S.C. § 102(b) is inappropriate.

Claim 22

5 Since claim 22 is the program storage device version of claim 1 with the same elements as claim 1 and since Skillen cannot teach each element of claim 1, Skillen also cannot teach each element of claim 22, and therefore, a rejection of claim 22 under 35 U.S.C. § 102(b) is inappropriate.

Claims 23 and 25

10 Since dependent claims 23 and 25 depend on independent claim 22 and since Skillen cannot teach each element of claim 22, Skillen also cannot teach each element of claims 23 and 25, and therefore, a rejection of claims 23 and 25 under 35 U.S.C. § 102(b) is inappropriate.

Claims 16-20, 26-29, 31, 35, and 36

Claim 16

15 To the extent the Examiner's language at page 4 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 16:

| Claim 16 | <u>Skillen</u> |
|--|---|
| A method for providing related advertisements for search result items from a search of an information repository, comprising: matching said <i>search result</i> items to said related advertisements; designating each of said <i>search result</i> items that have said related advertisements matched therewith; providing a corresponding graphical user interface for each of said | - <u>Skillen</u> does not teach this claim element. <u>Skillen</u> does not teach this claim element. <u>Skillen</u> does not teach this claim element. <u>Skillen</u> does not teach this claim element. |

| | |
|---|---|
| <p><i>search result</i> items so designated for subsequent user selection;</p> <p>searching and retrieving said related advertisements for one of said <i>search result</i> items when said corresponding graphical user interface is selected by a user; and,</p> <p>formatting and displaying said related advertisements upon selection.</p> | - |
|---|---|

In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 16, Skillen fails to teach “matching said *search result* items to said related advertisements”, as required by claim 16. Instead, Skillen teaches away from this claim element by teaching “[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument”, where the initial search argument is not the “*search result* items” required in claim 16. (See Skillen, page 9, lines 14-37 and page 10, lines 1-13.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, page 9, lines 14-37 and page 10, lines 1-13.) In contrast, claim 16 uses the results of an Internet search, the “*search result* items”, as inputs to a search of a repository of advertisements. Thus, Skillen cannot teach this element of claim 16.

For similar reasons, Skillen cannot teach “designating each of said *search result* items that have said related advertisements matched therewith”, cannot teach “providing a corresponding graphical user interface for each of said *search result* items so designated for subsequent user selection”, and cannot teach “searching and retrieving said related advertisements for one of said *search result* items when said corresponding graphical user interface is selected by a user”, as required by claim 16. It is therefore clear that Skillen cannot teach each element of claim 16 and, therefore, a rejection of claim 16 under 35 U.S.C. § 102(b) is inappropriate.

Claims 17-20

Since dependent claims 17-20 depend on independent claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claims 17-20, and therefore, a rejection of claims 17-20 under 35 U.S.C. § 102(b) is inappropriate.

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Claim 26

Skillen also cannot teach each element of claim 26 for reasons similar to the reasons why Skillen cannot teach each element of claim 16 and, therefore, a rejection of claim 26 under 35 U.S.C. § 102(b) is inappropriate.

Claims 27-29

10

Since dependent claims 27-29 depend on independent claim 26 and since Skillen cannot teach each element of claim 26, Skillen also cannot teach each element of claims 27-29, and therefore, a rejection of claims 27-29 under 35 U.S.C. § 102(b) is inappropriate.

Claim 31

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Since claim 31 is the program storage device version of claim 16 with the same elements as claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claim 31, and therefore, a rejection of claim 31 under 35 U.S.C. § 102(b) is inappropriate.

Claim 35

20

Since claim 35 is the computer program product version of claim 16 with the similar elements as claim 16 and since Skillen cannot teach each element of claim 16, Skillen also cannot teach each element of claim 35, and therefore, a rejection of claim 35 under 35 U.S.C. § 102(b) is inappropriate.

Claims 36

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Since dependent claim 36 depends on independent claim 35 and since Skillen cannot teach each element of claim 35, Skillen also cannot teach each element of claim 36, and therefore, a rejection of claim 36 under 35 U.S.C. § 102(b) is inappropriate.

Claims 32-34

Claim 32

To the extent the Examiner's language at page 3-5 of the Office Action can be understood, it appears that the Examiner has asserted the following correspondence between Skillen and claim 32:

| Claim 32 | <u>Skillen</u> |
|--|---|
| <p>A system for providing associated advertisements for search result items from an Internet search of an information repository, comprising:</p> <p style="padding-left: 40px;">a user/session manager means for maintaining and tracking <i>search result items</i> from user sessions, user queries, and advertisement requests;</p> <p style="padding-left: 40px;">a product database means for providing storage and retrieval for said associated advertisements;</p> <p style="padding-left: 40px;">a product matching manager means for analyzing said user sessions, said user queries, and said advertisement requests from said user/session manager and <i>matching</i> said associated advertisements from said product database corresponding to each of said <i>search result items</i>;</p> <p style="padding-left: 40px;">a request server means for displaying results from said search and displaying said associated advertisements from said product matching manager; and,</p> <p style="padding-left: 40px;">a product presentation manager means for referencing and retrieving said</p> | <p>-</p> <p><u>Skillen</u> does not teach this claim element.</p> <p>-</p> <p><u>Skillen</u> does not teach this claim element.</p> <p><u>Skillen</u> does not teach this claim element.</p> <p><u>Skillen</u> does not teach this claim element.</p> |

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| <p>associated advertisements that correspond to each of said <i>search result items</i>, in said product database, and to formulate said associated advertisements into a list, and pass said list to said request server.</p> | |
|--|--|

In reviewing the cited portions of Skillen, however, it becomes apparent that Skillen has been generalized, and, in fact, does not support the position asserted by the Examiner. With regard to claim 32, Skillen fails to teach “a product matching manager means for

5 analyzing said user sessions, said user queries, and said advertisement requests from said user/session manager and *matching* said associated advertisements from said product database corresponding to each of said *search result items*”, as required by claim 32. Instead, Skillen teaches away from this claim element by teaching “[looking] for a match in the product database 42 [by] determining a logical product fit to the initial search argument”, where the

10 initial search argument is not the “*search result items*” required in claim 32. (See Skillen, page 9, lines 14-37 and page 10, lines 1-13.) Skillen teaches uses the same search argument for an Internet search for a search of a product database. (See Skillen, page 9, lines 14-37 and page 10, lines 1-13.) In contrast, claim 32 uses the results of an Internet search, the “*search result items*”, as inputs to a search of a repository of advertisements. Thus, Skillen cannot

15 teach this element of claim 32.

For similar reasons, Skillen cannot teach “a user/session manager means for maintaining and tracking *search result items* from user sessions, user queries, and advertisement requests”, cannot teach “a request server means for displaying results from said search and displaying said associated advertisements from said product matching manager”,

20 and cannot teach “a product presentation manager means for referencing and retrieving said associated advertisements that correspond to each of said *search result items*, in said product database, and to formulate said associated advertisements into a list, and pass said list to said request server”, as required by claim 32. It is therefore clear that Skillen cannot teach each

element of claim 32 and, therefore, a rejection of claim 32 under 35 U.S.C. § 102(b) is inappropriate.

Claim 33

Since dependent claim 33 depends on independent claim 32 and since Skillen cannot
5 teach each element of claim 32, Skillen also cannot teach each element of claim 17-33, and
therefore, a rejection of claim 33 under 35 U.S.C. § 102(b) is inappropriate.

Claim 34

Since claim 34 is the computer program product version of claim 32 with the similar
elements as claim 32 and since Skillen cannot teach each element of claim 32, Skillen also
10 cannot teach each element of claim 34, and therefore, a rejection of claim 34 under 35 U.S.C.
§ 102(b) is inappropriate.

C. Whether claims 13, 14, 21, 30, and 37 are unpatentable under 35 U.S.C. § 103(a) as being obvious over Skillen

15 Applicants respectfully traverses the obviousness rejection of claims 13, 14, 21, 30, and
37 over Skillen, and submit that claims 13, 14, 21, 30, and 37 are not obvious over Skillen,
and are patentable thereover. In support of this position, Applicants submit the following
arguments:

20 1. Legal Standards for Obviousness

The following legal authorities set the general standards in support of Applicant's position
of non obviousness, with emphasis added for added clarity:

- 25 • MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish
prima facie obviousness of a claimed invention, **all the claim limitations must be taught
or suggested by the prior art.** In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).
"All words in a claim must be considered in judging the patentability of that claim
against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA
1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim
30 depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.
1988)."

- 5
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.**). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- 10
- "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." In re Fine, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See Raytheon Co. v. Roper Corp., 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- 15
- "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." **Obviousness can only be established by combining or modifying** the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so
- 20
- found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- 25
- "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See In re Zurko, 258 F.3d 1379 (Fed. Cir. 2001).
- 30
- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual
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- 40

evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembiczak, 175 F. 3d 994 (Fed. Cir. 1999).

- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed**." See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).

- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination**. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, **then there is no suggestion or motivation to make the proposed modification**. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

2. Application of the Obviousness Standard to the Present Invention

By the Final Office Action dated December 3, 2003, the Examiner has rejected claims 13, 14, 21, 30, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Skillen. In order to form a proper obviousness rejection of a claim under 35 U.S.C. § 103(a), a collection of references together must teach or suggest each element of the claim, including the relationships between the elements. If any element is not fully taught by the combined references, the rejection cannot be sustained.

Evaluating Skillen in this light, it is appropriate to examine the portions of Skillen that the Examiner has pointed to as teaching the claimed elements of the rejected claims.

Claim 13 and 14

Since Skillen cannot teach each element of claim 1, Skillen can neither teach nor suggest each element of claim 1, and, therefore, a rejection of claim 1 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 6 depends on claim 1 and since Skillen can neither teach nor suggest each element of claim 1, Skillen can neither teach nor suggest each element of claim 6 and, therefore, a rejection of claim 6 under 35 U.S.C. § 103(a) would also be inappropriate. Since claims 13 and 14 depend on claim 6 and since Skillen can neither teach nor suggest each element of claim 6, Skillen can neither teach nor suggest each element of claims 13 and 14, therefore, a rejection of claims 13 and 14 under 35 U.S.C. § 103(a) is inappropriate.

10 **Claim 21**

Since Skillen cannot teach each element of claim 16, Skillen can neither teach nor suggest each element of claim 16, and, therefore, a rejection of claim 16 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 21 depends on claim 16 and since Skillen can neither teach nor suggest each element of claim 16, Skillen can neither teach nor suggest each element of claim 21 and, therefore, a rejection of claim 21 under 35 U.S.C. § 103(a) is inappropriate.

15 **Claim 30**

Since Skillen cannot teach each element of claim 26, Skillen can neither teach nor suggest each element of claim 26, and, therefore, a rejection of claim 26 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 30 depends on claim 26 and since Skillen can neither teach nor suggest each element of claim 26, Skillen can neither teach nor suggest each element of claim 30 and, therefore, a rejection of claim 30 under 35 U.S.C. § 103(a) is inappropriate.

20 **Claim 37**

25 Since Skillen cannot teach each element of claim 36, Skillen can neither teach nor suggest each element of claim 36, and, therefore, a rejection of claim 36 under 35 U.S.C. § 103(a) would be inappropriate. Since claim 37 depends on claim 36 and since Skillen can neither teach nor suggest each element of claim 36, Skillen can neither teach nor suggest each

element of claim 37 and, therefore, a rejection of claim 37 under 35 U.S.C. § 103(a) is inappropriate.

CONCLUSION

All the claims presently on file in the present application are in condition for
5 immediate allowance, and such action is respectfully requested. It is respectfully submitted
that the application has now been brought into a condition where allowance of the case is
proper. Reconsideration and issuance of a Notice of Allowance are respectfully solicited.

Respectfully Submitted,



Leonard T. Guzman
Reg. No. 46,308

Date: April 5, 2004

IBM Almaden Research Center
650 Harry Road
C45A/J2B
San Jose, CA 95120

Phone Number: 408-927-3377
Facsimile Number: 408-927-3375

APPENDIX A

CLAIMS ON APPEAL

- 5 1. A method of targeting at least one associated advertisement from an Internet search having access to an information repository by a user, comprising:
- identifying at least one search result item from a search result of said Internet search by said user;
- searching for said at least one associated advertisement within said repository using
- 10 said at least one search result item;
- identifying said at least one associated advertisement from said repository having at least one word that matches said at least one search result item; and
- correlating said at least one associated advertisement with said at least one search
- 15 result item.
2. The method of claim 1 further comprising providing said at least one associated advertisement on demand by said user.
3. The method of claim 1 wherein said information repository is associated with an
- 20 Internet server.
5. The method of claim 1 further comprising displaying along with said at least one search result item a user-selectable icon containing a link to said at least one associated advertisement.
- 25 6. The method of claim 1 further comprising:
- designating said at least one search result item matched to said at least one associated advertisement for subsequent selection by a user.

7. The method of claim 6 further comprising first submitting a query to said information repository and obtaining said at least one search result item.
8. The method of claim 6 wherein designating said at least one search result item further
5 comprises displaying a graphical user interface to said user.
9. The method of claim 6 wherein said at least one associated advertisement comprises at least one related product advertisement.
- 10 10. The method of claim 6 further comprising assigning a user identifier prior to matching said at least one search result item to said at least one associated advertisement.
11. The method of claim 6 further comprising formatting said at least one associated advertisement matched with said at least one search result item so designated, prior to
15 displaying said at least one related product advertisement.
12. The method of claim 6 further comprising storing said at least one associated advertisement using a URL as an identifier for each of said at least one search result item.
- 20 13. The method of claim 6 further comprising performing an off-line batch process for each of said at least one search result item, wherein said batch process identifies said at least one associated advertisement for said at least one search result item.
14. The method of claim 6 further comprising providing a true/false designator to a user,
25 wherein said designator indicates whether said at least one associated advertisement exists for said at least one search result item.
15. The method of claim 8 wherein said graphical user interface comprises a product icon.

16. A method for providing related advertisements for search result items from a search of an information repository, comprising:

matching said search result items to said related advertisements;

designating each of said search result items that have said related advertisements

5 matched therewith;

providing a corresponding graphical user interface for each of said search result items so designated for subsequent user selection;

searching and retrieving said related advertisements for one of said search result items when said corresponding graphical user interface is selected by a user; and,

10 formatting and displaying said related advertisements upon selection.

17. The method of claim 16 further comprising assigning an identifier for said user when said user submits a query to said information repository.

15 18. The method of claim 16 wherein said related advertisements comprise related product advertisements.

19. The method of claim 16 wherein said graphical user interface comprises a product icon.

20

20. The method of claim 16 further comprising storing said related advertisements using a URL as an identifier for each of said search result items.

21. The method of claim 16 further comprising performing an off-line batch process for
25 each of said search result items, wherein said batch process identifies said related advertisements for said search result items.

22. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method steps for targeting at least one

associated advertisement from an Internet search having access to an information repository by a user, comprising:

identifying at least one search result item from a search result of said Internet search by said user;

5 searching for said at least one associated advertisement within said repository using said at least one search result item;

identifying said at least one associated advertisement from said repository having at least one a word that matches said at least one search result item; and

10 correlating said at least one associated advertisement with said at least one search result item.

23. The program storage device of claim 22 further comprising providing said at least one associated advertisement on demand by said user.

15 25. The program storage device of claim 22 further comprising displaying along with said at least one search result a user-selectable icon containing a link to said at least one associated advertisement.

20 26. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method steps for targeting related advertisements to individual search result items from a search of an information repository, said method steps comprising:

matching said individual search result items to said related advertisements; and,

25 designating those of said individual search result items matched to said related advertisements for subsequent selection by a user.

27. The program storage device of claim 26 further comprising the method step of first submitting a query to said information repository and obtaining said individual search result items.

28. The program storage device of claim 26 wherein designating said individual search result items further comprises displaying a graphical user interface to said user.

29. The program storage device of claim 26 further comprising the method step of storing
5 said related advertisements using a URL as an identifier for each of said individual search result items.

30. The program storage device of claim 26 further comprising the method step of
10 performing an off-line batch process for each of said individual search result items, wherein said batch process identifies said related advertisements for said search result items.

31. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform the method steps for providing related advertisements for search result items from a search of an information repository, comprising:
15 matching said search result items to said related advertisements;
designating each of said search result items that have said related advertisements matched therewith;
providing a corresponding graphical user interface for each of said search result items so designated for subsequent user selection;
20 searching and retrieving said related advertisements for one of said search result items when said corresponding graphical user interface is selected by a user; and,
formatting and displaying said related advertisements upon selection.

32. A system for providing associated advertisements for search result items from an
25 Internet search of an information repository, comprising:
a user/session manager means for maintaining and tracking search result items from user sessions, user queries, and advertisement requests;
a product database means for providing storage and retrieval for said associated advertisements;

a product matching manager means for analyzing said user sessions, said user queries, and said advertisement requests from said user/session manager and matching said associated advertisements from said product database corresponding to each of said search result items;

5 a request server means for displaying results from said search and displaying said associated advertisements from said product matching manager; and,

a product presentation manager means for referencing and retrieving said associated advertisements that correspond to each of said search result items, in said product database, and to formulate said associated advertisements into a list, and pass said list to said request server.

10

33. The system of claim 32 further comprising a search engine and a browser.

34. A computer program product for providing related advertisements for search result items from a search of an information repository, comprising:

15 a computer readable program code means for causing a computer to effect maintaining and tracking user sessions, user queries, and advertisement requests;

a computer readable program code means for causing a computer to effect providing storage and retrieval of said related advertisements;

20 a computer readable program code means for causing a computer to effect analyzing said search result items and matching said related advertisements corresponding to each of said search result items;

a computer readable program code means for causing a computer to effect displaying results from said search and displaying said related advertisements; and,

25 a computer readable program code means for causing a computer to effect referencing and retrieving said related advertisements corresponding to each of said search result items, formulating said related advertisements into a list, and presenting said list to a user.

35. A computer program product for selecting related advertisements for search result items from a search of an information repository, comprising:

a computer readable program code means for causing a computer to effect matching said search result items to said related advertisements;

a computer readable program code means for causing a computer to effect designating each of said search result items that have said related advertisements matched therewith;

5 a computer readable program code means for causing a computer to effect providing a corresponding graphical user interface for each of said search result items so designated for subsequent selection by a user;

a computer readable program code means for causing a computer to effect searching and retrieving said related advertisements for one of said search result items when said
10 corresponding graphical user interface is selected by said user; and,

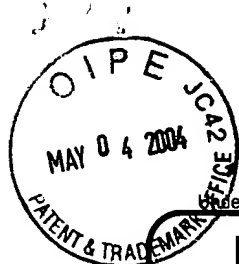
a computer readable program code means for causing a computer to effect formatting and displaying said related advertisements upon selection.

36. The computer program product of claim 35 further comprising

15 a computer readable program code means for causing a computer to effect submitting a query to said information repository; and,

a computer readable program code means for causing a computer to effect obtaining said search result items from said information repository.

20 37. The computer program product of claim 36 further comprising a computer readable program code means for causing a computer to effect assigning an identifier for said user when said query is submitted to said information repository.



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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**330.00**

Complete if Known

Application Number 09/583,516
Filing Date 05/31/2000
First Named Inventor Michael L. Emens
Examiner Name Raquel Alvarez
Art Unit 3622
Attorney Docket No. AM9-99-0118

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METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

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Deposit Account Number
Deposit Account Name

09-0441

IBM Corporation

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|------------------------|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |

SUBTOTAL (1) (\$)**0-00**

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims | | Extra Claims | | Fee from below | Fee Paid |
|--------------------|--------------------|--------------|--------|----------------|----------|
| Independent Claims | Multiple Dependent | -20** = | -3** = | | |
| | | | | | |

| Large Entity | | Small Entity | | Fee Description |
|--------------|----------|--------------|----------|--|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | |
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 |
| 1203 | 290 | 2203 | 145 | Multiple dependent claim, if not paid |
| 1204 | 86 | 2204 | 43 | ** Reissue independent claims over original patent |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$)**0-00**

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Entity | | Small Entity | | Fee Description | Fee Paid |
|--------------|----------|--------------|----------|--|----------|
| Fee Code | Fee (\$) | Fee Code | Fee (\$) | | |
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | 330. |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,330 | 2453 | 665 | Petition to revive - unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design issue fee | |
| 1503 | 640 | 2503 | 320 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**330.00**

SUBMITTED BY

(Complete if applicable)

Name (Print/Type) Leonard T. Guzman
Registration No. (Attorney/Agent) 46,308
Telephone 408-927-3377
Signature
Date April 5, 2004

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TRANSMITTAL FORM

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| Application Number | 09/583,516 |
| Filing Date | 5/31/2000 |
| First Named Inventor | MICHAEL L. EMENS |
| Art Unit | 3622 |
| Examiner Name | RAQUEL ALVAREZ |
| Attorney Docket Number | AM9-99-0118 |
| Total Number of Pages in This Submission | 73 |

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| <input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance communication to Group <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice <u>Brief</u> Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): RETURN POSTCARD, TRANSMITTAL FORM |
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| Signature | <i>Leonard T. Guzman</i> |
| Date | April 5, 2004 |

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